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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,383	03/19/2004	George Austria	54029.8016.US01	7235
34055	7590	04/21/2005	EXAMINER	
PERKINS COIE LLP POST OFFICE BOX 1208 SEATTLE, WA 98111-1208			NINO, ADOLFO	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,383

Applicant(s)

AUSTRIA ET AL.

Examiner

Adolfo Nino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8 and 20-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Haibach et al. (US 5,211,784).

Regarding claim 1 (currently amended), Haibach et al. disclose a disposable cord and tubing cover (12) for providing an easily visible indication to operating room personnel of the presence of cords or tubs on the floor of the operating room, comprising: a flexible sheet (12; col. 4) having a top surface and a bottom surface, with the bottom surface including: a pliable interior region (15) for draping over and covering one or more cords (11) resting on a support surface (fig. 1); first (16) and second exterior regions (16) on either side of the interior region (fig. 1); an adhesive material (16) on at least one of the first and second exterior regions (16) for securing the flexible sheet to the support surface; and with top surface having a bright color so that the cover is visually noticeable (col. 4, lines 50-54). **Note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 2, Haibach et al. disclose the cord and tubing cover (12) of claim 1 wherein the adhesive material (16) comprises a two-sided adhesive tape (col. 4, lines 11-14).

Regarding claim 3, Haibach et al. disclose the cord and tubing cover (12) of claim 2 wherein each of the first and second exterior regions (16) includes a strip of the two-sided adhesive tape (fig. 1).

Regarding claim 4, Haibach et al. disclose the cord and tubing cover (12) of claim 2 further comprising removable release paper on the adhesive tape (not mentioned, but it is inherent to have the removable release paper on the adhesive tape since the cover is shown as a roll in fig. 1 already with the two-sided adhesive tape attached).

Regarding claim 8, Haibach et al. disclose the cord and tubing cover of claim 1 wherein the adhesive material is sprayed onto the flexible sheet. Note that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it, which is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

Regarding claim 20 (new), Haibach et al. disclose the cord and tubing cover of claim 1 wherein the flexible sheet is rolled up into a roll (col. 3, line 43).

Regarding claim 21 (new), Haibach et al. disclose the cord and tubing cover of claim 1 wherein the flexible sheet is orange (col. 3, line 45).

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Regarding claim 22 (new), Haibach et al. disclose a disposable cord and tubing cover for providing an easily visible indication to operating room personnel of the presence of cords or tubes on the floor of the operating room, comprising: a flexible sheet (12; col. 4) having a top surface and a bottom surface, with the bottom surface including: a pliable interior region (15) for draping over and covering one or more cords (11) resting on a support surface; first (16) and second exterior regions (16) on either side of the interior region a two-sided adhesive tape on the first and second exterior regions for securing the flexible sheet to the support surface, and a removable release paper on the adhesive tape; and with top surface having a bright color so that the cover is visually noticeable (col. 3, line 45). **Note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haibach et al. (US 5,211,784) in view of Corpuel (US 6,137,901 B1).

Regarding claim 5, Haibach et al. disclose the cord and tubing cover (12) of claim 1 **except for** explicitly stating that the flexible sheet (12) comprises a non-skid material. Haibach et al. disclose the flexible sheet (12) to have been made of any suitable flexible synthetic or natural material such as vinyl (col. 3, lines 3-9). Corpuel shows that vinyl is a non-skid material (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the flexible sheet of Haibach et al. out of vinyl, since Corpuel teaches that vinyl is known as a non-skid material.

Regarding claim 6, the modified Haibach et al. disclose the cord and tubing cover (12) of claim 5 wherein the non-skid material comprises PVC foam (abstract of Corpuel).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haibach et al. (US 5,211,784) in view of Vockel et al. (US 5,223,330). Haibach et al. disclose the

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cord and tubing cover (4) of claim 1 **except for** the flexible sheet comprising a luminous material that glows in the dark. Vockel et al. teach that it is known to have a flexible material comprising a luminous material as set forth at column 1, lines 48-55. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the flexible sheet of Haibach et al. comprised a luminous material as taught by Vockel et al. in order for the cord and tubing cover of Miller to be able to glow in the dark as noted on column 4, lines 20-30 of Vockel et al.

Response to Arguments

Applicant's arguments with respect to independent claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adolfo Nino whose telephone number is (571) 272-1981. The examiner can normally be reached on M-F (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-2800 ext. 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AN


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4/18/05